

REMARKS

Applicants acknowledge receipt of the Office Action dated April 2, 2007.

Status of Claims.

Claim 10 is currently amended;

Claims 1-9 and 18-19 are canceled;

Claims 10-13, 15-17, and 20-23 are pending in the application.

Claim Amendment.

Claim 10 is currently amended to require that the at least one insulator sequence is a multiple palindromic restriction site. This amendment is responsive to the Examiner's statements (at page 3, lines 1-2, and page 6, lines 3-8, of the Office Action mailed April 2, 2007) that the features upon which Applicant relies (*i.e.*, multiple palindromic restriction sites) are not recited in the rejected claim(s).

Implicit support for this amendment can be found at page 15, lines 22-30 of the specification (which corresponds to paragraph [0102] of U.S. Patent Application Publication No. 2006/0105341), which reads as follows:

Insulator elements may be placed on either side of the RNA tags and function to ensure proper folding of the RNA tags and to discourage interactions between the tags and the target RNA sequence. Examples of suitable insulator elements include, but are not limited to stretches of 4-5 identical nucleotides (eg, adenosines) coupled with paired restriction sites that do not interact with the tag or bait sequences. The 5' and 3' restriction sites should be identical as these sequences can then hybridize, forming a stem that forces the "insulator" polynucleotide sequences to be "unpaired" thus isolating the internal tag or bait structures from the remainder of the RNA sequences produced from a specific vector. Insulator elements may also be called spacers.

While the term "palindromic" is not used, verbatim, in that passage of the specification, it does not constitute new matter because one of skill in the art would have understood at the time of the invention that "palindromic" is an equivalent and concise way of wording the phrase "the 5' and 3' restriction sites should be identical." The word "palindromic" is well known to refer to a word or phrase that reads the same backward or forward. See, for example, Webster's Third New International Dictionary, 2002, Merriam-Webster Company, Springfield, MA.

Claim Rejections under 35 U.S.C. § 102(a)

Claims 10, 12, 15–17 and 20–22 remain rejected under 35 U.S.C. § 102(b) as being anticipated by *Srisawat et al.* As noted above, Applicants have amended claim 10 to require that the at least one insulator sequence is a multiple palindromic restriction site. Clearly *Srisawat et al.* do teach or disclose this feature. Applicants, therefore, respectfully submit that independent claim 10 and claims 12, 15–17 and 20–22 which depend therefrom, distinguish over *Srisawat et al.*

Claim Rejections under 35 U.S.C. § 103(a)

Srisawat et al. and Rigaut et al.

Claims 10–12, 15–17 and 20–22 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over *Srisawat et al.* in view of *Rigaut et al.* Applicants respectfully submit that *Rigaut et al.* do not teach or disclose that the insulator sequence is a multiple palindromic restriction site. Therefore, the teaching of *Rigaut et al.* does not cure the above-mentioned deficiencies of *Srisawat et al.* Applicants, therefore, respectfully submit that claim 10, as currently amended, and claims 11–12, 15–17 and 20–22, which depend from claim 10, are non-obvious over the combined teachings of *Srisawat et al.* and *Rigaut et al.*

Srisawat et al. and Johansson et al.

Claims 10, 12–13, 15–17 and 20–22 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over *Srisawat et al.* in view of *Johansson et al.* Applicants respectfully submit that *Johansson et al.* also do not teach or disclose that the insulator sequence is a multiple palindromic restriction site. Therefore, the teaching of *Johansson et al.* does not cure the above-mentioned deficiencies of *Srisawat et al.* It is respectfully submitted that claim 10, as currently amended, and claims 12–13, 15–17 and 20–22, which depend from claim 10, are non-obvious over *Srisawat et al.* in view of *Johansson et al.*

Srisawat et al., Bachler et al., Bardwell et al. and Boniface et al.

Claims 10–13, 15–17 and 20–22 are newly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Srisawat et al.* in view of the combined teachings of Bachler et al. (*Methods*, 2002, 26:15–161), Bardwell et al. (*Nucleic Acids Research*, 1990, 18:6587–6594) and Boniface et al. (U.S. Patent App. Pub. 2005/0118646). None of *Bachler et al.*, *Bardwell et al.* and

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Boniface et al. teach or suggest that the at least one insulator sequence is a multiple palindromic restriction site. These references, therefore, fail to cure the above-mentioned deficiencies of *Srisawt et al.* with respect to claims 10–13, 15–17 and 20–22.

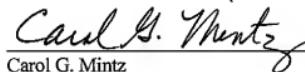
Conclusion

Applicants respectfully request entry of the amendment, withdrawal of the rejections and allowance of the pending claims. If the Examiner feels that a telephone conference might expedite the resolution of any issue that may remain in this case, the Examiner is invited to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art that have yet to be raised, but which may be raised in the future.

It is believed that no extensions of time or fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that any additional extension of time is necessary to allow consideration of this paper, such extension is hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 03-2769 (ref. 1889-00900) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,


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